

**REMARKS**

Applicant respectfully requests reconsideration and allowance of the subject application. Claim 7 is amended and new claims 21-28 are added. Claims 1-28 are pending in the application.

5 The amendment to claim 7 addresses minor informalities noted during review, however, the amendment to claim 7 is not intended to alter the scope of the claims.

10 The Advisory Action dated May 20, 2003 states (Summary, continued on last page) that "does NOT place the application in condition for allowance because: Applicant's arguments regard removing curl which is only recited in the independent claims. No positively [sic] recited method steps of removing curl are recited in the claims."

15 Only two paragraphs of Applicant's Response address the recitation of removal of roll set curl as recited in claim 1. The acts recited in claim 1 are directed to a method of removing roll set curl; taken together, such acts result in substantial removal of roll set curl. The Examiner has offered no authority for the opinion that the claims must include explicit recitation of an act of removal of roll set curl. Furthermore, 35 U.S.C. §103(a) provide that the subject matter as a whole must be considered in determining patentability.

20 Claim 10 and claims dependent therefrom are directed to a method of printing on both sides of a print medium rolled on a core ...." These claims do not include any recitation of removing roll curl and the arguments with respect to these claims are similarly devoid of discussion of removing of roll curl. Clarification is requested.

25 Claims 1-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Silverbrook et al., U.S. Patent No. 6,443,555 (hereinafter

"Silverbrook") and Hatta, Japanese Patent Application No. 07-314832 A (hereinafter "Hatta"), alone or in combination with one or more of Yonekubo, U.S. Patent Application No. US2001/0055041 A1; Clark, U.S. Patent No. 6,406,126 B1; Kaneko et al., Japanese Patent Application No. 04-345878 A; 5 Winter et al, U.S. Patent No. 6,015,207; Shinohara et al., Japanese Patent Application No. 08-292505 A; Suga, Japanese Patent Application No. 05-155106 A; Ishida, Japanese Patent Application No. 09-286128; or Takayama et al., U.S. Patent No. 6,222,570 B1. Applicant traverses and requests reconsideration.

10 Silverbrook discloses "A pagewidth inkjet printer including: a printhead assembly having an elongate pagewidth array of inkjet nozzles, chambers and thermal bend actuators formed using MEMS techniques; wherein the array extends at least 36 inches (914 mm) in length; and, the printhead assembly being constructed and arranged such that adequate heat dissipation occurs at 15 equilibrium operating conditions without a forced heat exchange system." (Abstract). As such, Silverbrook is primarily concerned with design of the inkjet assembly for high speed printing. Silverbrook is completely silent with respect to paper curl or double sided printing. Accordingly, Silverbrook does not even recognize the problem to be solved and cannot provide motivation or 20 suggestion as to potential solutions to the problems addressed by Applicant's disclosure.

Hatta discloses a journal printer (Title) in which the principal objective is to take up a roll paper on a take-up spool such that the outside face of the roll paper is in a white state by mounting a printer roll paper on the take-up spool 25 with its printed face inside. (Abstract; Purpose).

In contrast, Applicant's claim 1 recites "A method of removing roll-set curl in a print medium rolled on a core utilizing a large format printer equipped

with a take up reel ("TUR"), said method comprising the steps of: activating a TUR having a core; loading said rolled print medium into said large format printer; advancing said rolled print medium through said large format printer until a front edge of said rolled print medium is adjacent to said TUR; attaching 5 said front edge of said rolled print medium to said core of said TUR, such that a surface to be printed upon of said rolled print medium faces said core of said TUR; and rotating said core of said TUR in a direction substantially opposite a direction of said rolled print medium on said core to substantially wind said rolled print medium on to said core of said TUR", which is not taught, disclosed, suggested or motivated by the cited references.

10 Applicant's claim 10 recites "A method of printing on both sides of a print medium rolled on a core utilizing a large format printer equipped with a take up reel ("TUR"), said method comprising the steps of: activating a TUR having a first core; loading said rolled print medium into said large format printer; sending a plot stream to said large format printer; printing said plot stream onto a first surface of said rolled print medium; advancing said rolled print medium through said large format printer until a front edge of said rolled print medium is adjacent to said TUR; attaching said front edge of said rolled print medium to said first core of said TUR, such that a surface to be printed 15 upon of said rolled print medium faces said first core of said TUR; and rotating said first core of said TUR in a direction substantially opposite a direction of said print medium roll to substantially wind said rolled print medium on to said first core of said TUR", which is not taught, disclosed, suggested or motivated by the cited references.

20 25 Silverbrook and Hatta are both silent with respect to removing roll-set curl, as recited in claim 1. Silverbrook is silent with respect to any aspect of

printing on both sides of a print medium, as recited in claim 10. Hatta indicates that such is possible but provides no teaching whatsoever of doing so.

Both references are silent with respect to "advancing said rolled print medium ... until a front edge of said rolled print medium is adjacent to said 5 TUR, as affirmatively recited in both claims 1 and 10. Both references are similarly silent with respect to then "attaching said front edge of said rolled print medium to said core of said TUR".

Both references are also silent with respect to doing so "such that a surface to be printed upon of said rolled print medium faces said core of said 10 TUR", as affirmatively recited in both claims 1 and 10. As such, the proposed combination does not and cannot provide the claimed subject matter.

The Office Action states (pp. 2, 3), with respect to Silverbrook, that "the leading edge of the paper ... must be inserted into the take-up spool in order for the printer to function." Silverbrook provides no such teaching.

15 Silverbrook teaches that the paper may be cut as it is printed (col. 7, line 59 et seq.) and that the paper is advanced by rollers 10 and 13 (col. 6, lines 46-53). Additionally, the view of Fig. 12 shows the end of the roll of paper as it advances but shows no take-up spool. As such, Silverbrook does not support the statement in the Office Action.

20 The Office Action further states (pp. 2, 3) that "Hatta discloses a printer in which a print head 1 is used to print on both sides of a printing medium 4 (see last sentence of machine translation). Figures 1 and 3 of Hatta show how a take-up spool can be arranged so that both sides are printed, thus both sides of medium 4 are to be printed upon and one of the sides to be printed on will 25 always face the take-up core."

Hatta does not disclose printing on both sides of a printing medium with a print head 1. Hatta explicitly states that Fig. 1 shows the printed side of the

paper on the inside of the take-up roll (par. 16, 19) and that the outside field is in the state of a blank paper." Hatta is utterly silent as to how the "outside field" might be printed and makes no allegation at all regarding printing such with the print head 1.

5 Hatta states (machine translation) that Fig. 3 depicts printing according to the prior art (par. 4 - par. 7) and that "the outside field is printing side 4b". Hatta teaches (par. 9) that the prior art as shown in Figure 3 has problems since "only one side of the field is used" the costs are high, "and that has the trouble of also needing many storage space". Hatta does not teach printing both sides 10 of the roll, as alleged, and further, combining the teachings of Hatta with the disadvantages of the prior art as taught by Hatta clearly comprises improper modification of the teachings of a reference, changes the principle of operation of the reference and renders the teachings of the reference unsuited for its intended purpose. As such, the characterization of the teachings of Hatta 15 provided in the Office Action is both improper, as a matter of law, and inaccurate.

As noted in the Response dated January 29, 2003, the primary reference, Silverbrook, fails to disclose, teach, or suggest attaching a front edge of a rolled print medium to a core of a take up roll, such that a surface to be printed upon 20 of the rolled print medium faces the core of the take up roll. In fact, Silverbrook is utterly silent with respect to how the printed roll is coupled to the take-up spool. Hatta is similarly silent with respect to attaching the front edge of a rolled print medium to a core of a take up roll.

It is a main intent and intended purpose of Hatta to alter a printer in such 25 a way as to cause a roll of printed matter to be wound on a take-up spool with a printed side facing the spool and with an unprinted side facing away from the spool.

In contrast to the intended purpose of Hatta, and as noted in the Response dated January 29, 2003, Silverbrook's Fig. 26 shows winding media to a take up spool such that an unprinted surface of the media faces the core of the take up spool and such that a surface to be printed upon faces opposite of the take up spool. Thus, not only does Silverbrook not meet all of Applicant's claim recitations, Silverbrook shows the exact opposite of Applicant's claim recitations and shows precisely what Hatta labels as the problem Hatta seeks to resolve.

Hatta teaches directly away from the disclosure of Silverbrook. Further, 10 modifying the teachings of Hatta to attempt to arrive at the subject matter of Applicant's claims 1 or 10 renders the teachings of Hatta unsuitable for their intended purpose.

Applicant notes the requirements of MPEP §2143.01, in a subsection entitled "THE PROPOSED MODIFICATION CANNOT RENDER THE 15 PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE". This subsection states that "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) ...." Because modification of 20 Hatta to include the teachings of Silverbrook defeats the intended purpose taught by Hatta, it is improper to combine the teachings of these references in an attempt to find unpatentability.

Applicant notes the requirements of MPEP §2143.01, entitled "Suggestion or Motivation To Modify the References." This MPEP portion 25 includes a subsection stating that "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION". Inasmuch as both prior art references are silent with respect to the problem to be solved, it is

inconceivable that the references could suggest the desirability of the claimed invention.

5 Applicant further notes that, as there is no basis for the Examiner's contentions within the cited references, the only possible motivation for these contentions is hindsight reconstruction wherein the Examiner is utilizing Applicant's own disclosure to construct a reason for combining the cited references using an improper "obvious to try" standard for unpatentability.

10 The Examiner is reminded that hindsight reconstruction is not an appropriate basis for a §103 rejection. (See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) (explaining that hindsight reconstruction is an improper basis for rejection of a claim).)

15 The impermissibility of the rationale given in the Office Action is also discussed in MPEP §2145(X)(B), entitled "Obvious To Try Rationale". This MPEP section states that "An applicant may argue the examiner is applying an improper "obvious to try" rationale in support of an obviousness rejection."

20 This MPEP section further states that "The admonition that 'obvious to try' is not the standard under § 103 has been directed mainly at two kinds of error. In some cases, what would have been 'obvious to try' would have been to vary all parameters or try each of numerous possible choices until one possibly arrived at a successful result, where the prior art gave either no indication of which parameters were critical or no direction as to which of many possible choices is likely to be successful ..." The references cannot identify which parameters are critical if they do not recognize the problem to be solved, and 25 they cannot provide direction as to which choices may succeed when they do not provide the elements recited in the claims.

This MPEP section also states that "In others, what was 'obvious to try' was to explore a new technology or general approach that seemed to be a promising field of experimentation, where the prior art gave only general guidance as to the particular form of the claimed invention or how to achieve it." *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988)". Mere misrepresentation of the teachings of the references fails to elevate the arguments contained in the Office Action above such an "obvious to try" standard.

The Office Action fails to establish a prima facie case of obviousness.

10 Applicant notes that criteria for such are set forth in MPEP §2143, entitled "Basic Requirements of a Prima Facie Case of Obviousness" (see also MPEP §706.02(j)).

This MPEP section states that "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." No motivation has been identified in references by the Office Action to modify or combine the reference disclosures.

20 This MPEP section also states that "Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." As noted above, the references fail to teach or suggest all of the recitations of the claims. As such, there can be no reasonable expectation of success.

25 This MPEP section further states that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947

F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." As a result, the rejection fails all prongs of the test set forth in the MPEP for a *prima facie* finding of unpatentability.

Moreover, no evidence has been provided as to why it would be obvious 5 to combine the teachings of these references. Evidence of a suggestion to combine may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re* 10 *Dembiczak*, 175 F.3d 994, 998 (Fed. Cir. 1999).

With respect to Yonekubo (U.S. Patent Application No. US2001/0055041 A1), Clark (U.S. Patent No. 6,406,126 B1), Kaneko et al.(Japanese Patent Application No. 04-345878 A), Winter et al. (U.S. Patent No. 6,015,207), Shinohara et al. (Japanese Patent Application No. 08-292505 15 A), Suga (Japanese Patent Application No. 05-155106 A), Ishida (Japanese Patent Application No. 09-286128), and Takayama et al. (U.S. Patent No. 6,222,570 B1), Applicant respectfully submits that none of these references cures the deficiencies of Silverbrook and Hatta as discussed above, and thus 20 that claims 1-20 should be allowed over Silverbrook and Hatta in view of these references.

Accordingly, (i) the references fail to provide the elements recited in Applicant's claims, (ii) the references have been mischaracterized in the Office Action, and have been improperly applied, (iii) the rejection fails to meet the standards set forth for finding unpatentability, (iv) the references teach away 25 from one another, (v) the teachings of Hatta are rendered unsuitable for their intended purpose if modified as suggested in the Office Action or if combined with the teachings of Silverbrook, (vi) the rejection employs an improper

"obvious to try" rationale and (vii) no evidence has been provided as to why it would be obvious to combine the teachings of these references. Accordingly, the unpatentability rejection of claims 1 and 10 and claims dependent therefrom is improper and should be withdrawn, and claims 1-20 should be allowed.

5       Applicant notes the requirements of MPEP §707.07(f), entitled "Answer All Material Traversed". This MPEP section states that "Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she 10 repeats the rejection, take note of the applicant's argument and answer the substance of it."

Applicant notes that this is explained further by the requirements of MPEP §707.07, entitled "Completeness and Clarity of Examiner's Action". This MPEP section cites 37 CFR §1.104, entitled "Nature of examination" 15 which in turn states, in subsection (b), entitled "Completeness of examiner's action" that "The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made."

20       This MPEP section further states, under a heading labeled "Examiner Note" that "The Examiner must however, address any arguments presented by the applicant which are still relevant to any references being applied."

Applicant has provided at least seven (7) different arguments traversing the unpatentability rejections. In the event that the Examiner continues to reject 25 Applicant's claims by applying the same references, the Examiner should affirmatively respond to each of the arguments set forth by Applicant.

New Claims

New claims 21-28 are supported at least by text appearing at p. 4, line 9, through p. 14, line 12 of the application as originally filed. No new matter is added by new claims 21-28. New claims 21-28 distinguish over the art of record and are allowable.

Conclusion

Claims 1-28 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

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Respectfully Submitted,

  
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**MARKED UP VERSION OF THE AMENDMENTS IN COMPLIANCE**  
**WITH 37 C.F.R. § 1.121**

In compliance with this section, Applicant submits the following marked up version only for the sections of the specification being changed by the current amendment, wherein the markings are shown by brackets (for deleted matter) and/or underlining (for added matter):

7. (Amended) The method according to claim 6, wherein said step [at] of activating said extended margins feature comprises the step of turning on said extended margins feature in a front panel of said large format printer.

New claims 21-28 are added.

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**END OF DOCUMENT**